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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,472	05/28/2002	Hiroshi Nagase	1038-02	4103

35811 7590 07/18/2005

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EXAMINER

ROYDS, LESLIE A

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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07132005

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner for Patents

See attached Notice Of Non-Responsive Amendment.

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**NOTICE OF NON-RESPONSIVE AMENDMENT**

This notice of non-responsive amendment is in reply to Applicant's amendment filed June 29, 2005, which has been received and entered into the application.

The MPEP states at §819:

“The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter.”

Newly submitted claims 1-4 and 8-9 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are now drawn to a method of treating neuropathic pain comprising administering to a mammal a therapeutically effective amount of a composition comprising a compound represented by general formula (I) (see currently amended claim 1, for example), where the claims as originally filed were drawn to a therapeutic agent (i.e., composition of matter).

The inventions are independent or distinct because they are related as product and process of use and can be shown to be distinct if: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process of using the claimed compound for treating neuropathic pain can be practiced with other materially different products, such as therapeutic spinal cord stimulation and dorsal root entry zone lesions or chronic intrathecal administration of baclofen and ketamine (see Applicant's acknowledgement at page 14, second paragraph). For this reason, the inventions are considered to be patentably distinct.

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Since Applicant has received an action on the merits for the originally presented invention (i.e., the therapeutic agent), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, all claims are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The amendment filed on June 29, 2005 presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The claims are not readable on the elected invention because they are now drawn to a method of treating neuropathic pain comprising the administration to a mammal of a therapeutically effective amount of a composition comprising a compound represented by general formula (I), while the elected invention (i.e., the invention of the originally presented claims) was drawn to a therapeutic agent (i.e., composition of matter).

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of **ONE (1) MONTH** or **THIRTY (30) DAYS**, whichever is longer, from the mailing date of this notice within which to supply the omission or correction, as well as a proper response to the previous Office Action, in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.**

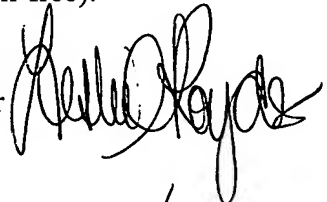
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The Examiner can normally be reached on Monday-Friday (8:30 AM-6:00 PM), alternate Fridays off.

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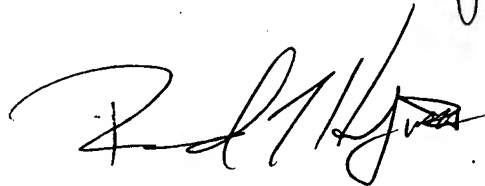
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christopher Low can be reached on (571)-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-272-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Leslie A. Royds  
Patent Examiner  
Art Unit 1614



July 13, 2005



**RAYMOND HENLEY III**  
**PRIMARY EXAMINER**  
Art Unit 1614